REMARKS

Claims 16, 17 and 20-27 are pending in the present application. Claims 16, 22 and 27 have been amended as set forth above and as shown in Appendix A. It is respectfully submitted that the pending claims define allowable subject matter.

The Examiner requested the Applicants to furnish a supplemental IDS with copies of foreign and npl references that were apparently not included with the IDS filed December 16, 2002. The Applicants respectfully submit that copies of these references were, in fact, sent with the original IDS on December 16, 2002. The Applicants have enclosed a copy of the IDS and PTO form 1449, which were filed on December 16, 2002, under Express Mail # EL849000538US. Additionally, the Applicants have enclosed a copy of the post card sent on that same date. As shown in the IDS, seventy-five (75) references were submitted with the IDS and PTO form 1449, including the aforementioned foreign and npl references. The post card also indicates that 75 references were mailed to the United States Patent and Trademark Office on December 16, 2002. Nevertheless, the Applicants have resubmitted copies of the foreign and npl references for the Examiner's convenience.

The Applicants have also submitted an Associate Power of Attorney, requesting that Joseph M. Butscher be recognized as an associate attorney, and therefore an attorney of record for the present application. The Applicants note that Mr. Butscher was previously authorized to represent the Applicants pursuant to 37 CFR 1.34(a).

Claims 16-27 were rejected under the judicially created doctrine of double patenting over claims 1-11 of United States Patent No. 6,397,189. Claims 22-23 and 25-27 were rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,726,909. Claims 16-17 and 20 were rejected under 35 US.C. 103(a) as being unpatentable over United States Patent 5,497,502 in view of United States Patent No. 4,949,187, further in view of United States Patent Nos. 4,667,802 or 4,958,835. Claims 22-23 and 25-27 were also rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,497,502 in view of United States Patent No. 4,949,187. Claims 21 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,497,502 in view of United States Patent No. 4,949,187 in view of

Official Notice. The Applicants respectfully traverse these rejections for the reasons discussed below.

The Applicants now turn to the rejection of Claims 16-27 under the judicially created doctrine of double patenting over claims 1-11 of U.S. Patent No. 6,397,189. As per a phone interview on December 9, 2002, the Applicants informed the Examiner that the published claims of the '189 patent do not accurately reflect the actual scope of the claims. When the '189 patent was published, various limitations added during prosecution were not entered. A Certificate of Correction has been filed for the '189 patent to correct the omission of those claim limitations. Moreover, the Applicants amended the claims of the current application so that the current claims are no longer coextensive in scope with the published, although erroneous, claims of the '189 patent. *See* December 16, 2002 Amendment. In an effort to expedite the prosecution of the current application, the Applicants have enclosed a Terminal Disclaimer to obviate any non-statutory double patenting issues that may arise in relation to the '189 patent.

The Applicants next turn to the rejection of claims 22-23, 25-27 under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,736,909 ("Krikorkian"). 35 U.S.C. 102(b) states the following:

> A person shall be entitled to a patent unless – the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...

As noted above, the present application is a continuation of U.S. Patent Application Serial No. 09/076,849, filed May 12, 1998, now abandoned, which is a continuation of U.S. Patent Application Serial No. 08/584,253, filed January 11, 1996, now U.S. Patent No. 5,781,889, which is a continuation of U.S. Patent Application Serial No. 08/268,782, filed June 30, 1994, now abandoned, which is a division of U.S. Patent Application Serial No. 07/846,707, filed March 6, 1992, now U.S. Patent No. 5,455,302. *See also* May 23, 2001 Preliminary Amendment. Thus, the present application claims a priority chain all the way back to March 6, 1992.

Krikorian, on the other hand, was *filed* December 8, 1995 and *published* on March 10, 1998 (i.e., Krikorian issued on March 10. 1998). The present application claims priority to an application that was filed March 6, 1992, which antedates the filing date of Krikorian by more

than three and a half years and the publication date of Krikorian by more than six years. The Applicants respectfully submit that Krikorian is not proper prior art under 35 U.S.C. 102(b).

The Applicants now turn to the rejection of claims 16-17 and 20 under 35 USC 103(a) as being unpatentable over United States Patent No. 5,497,502 ("Castille") in view of United States Patent 4,949,187 ("Cohen") further in view of United States Patent 4,667,802 ("Verdun") or United States Patent No. 4,958,835 ("Tashiro"). As an initial matter, the Applicants respectfully submit that the combination of Castille and Cohen do *not* teach the audio/video distribution system claimed, as asserted by the Examiner.

Castille, in the Abstract, discloses the following:

> [A] method and apparatus for transmitting information recorded on a collection of digital disks from a central server via a high data rate digital telecommunications network to subscribers connected to the network.

In Castille, a server center 1 is connected to a high data rate telecommunications network 2 capable of conveying digital information at a high rate. A plurality of subscriber serving stations 3 are connected to the telecommunications network 2. The server center 1 includes a programmable controller 6 controlled by a computer 4, which is connected to the network by a communications interface circuit 5.

In column 10, lines 20-22, Castille discloses that "the disk controller 6 controls the various electromechanical equipments (sic) of the central server in a manner *analogous* to the disk handler of a jukebox." However, Castille does not teach, nor suggest, that the subscriber serving stations are, or include, jukeboxes. In fact, Castille does not teach, nor suggest a method or apparatus that includes computer jukeboxes. Independent claims 16, 22 and 27 have been amended to recite that the computer jukebox includes "a money intake device for receiving money of a user of the computer jukebox, wherein the user inserts money into the money intake device to play at least one song on the computer jukebox" in order to more clearly point out that the claims are directed to computer jukeboxes. Castille does not teach, nor suggest, a computer jukebox; and it certainly does not teach, nor suggest, a computer jukebox having a money intake device.

Cohen, in the Abstract, discloses the following:

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> A video communications system is provided that makes it possible for home viewer to download a movie in digital format from a large archive library, store the digital movie file locally, and view the movie at any convenient time.

Similar to Castille, however, Cohen does not teach, nor suggest, a computer jukebox. Nor does Cohen teach or suggest a computer jukebox that includes a money intake device.

Verduin, in the Abstract, discloses the following:

> A video jukebox responsive to the deposit of money and to the actuation of a selection system for activating a *phonograph* to play a record for a first price and for activating that one of a pair of video *tape* players which is closest to a selected audio-video recording for a second price.

Verduin discloses video cassette recorders 54 and 62 and a graphics generator 70. However, Verduin does not teach, not suggest a jukebox that plays *digital* songs or displays images that have been stored *digitally*. Claim 16 has been amended to clearly recite that the song associated graphic images are digitally stored. The combination of Castille, Cohen and Verduin, alone or in combination with one another, does not teach, nor suggest, a computer jukebox, which includes a money intake device, that stores digital songs and digital song associated graphic images.

Tashiro, at Column 1, lines 5-9, states that "[t]he present invention relates to a game playing system for commercial use and particularly to such a system enabling a plurality of players to play a game simultaneously in the same game space." Obviously, Tashiro is not directed toward a jukebox. Further, Tashiro does not teach, nor suggest, a jukebox. Rather, Tashiro is directed toward video games, but not a jukebox that plays songs. Thus, Tashiro does not teach, nor suggest, *song associated* digital graphic images. The combination of Castille, Cohen and Tashiro *and/or* Verduin, alone or in combination with one another, does not teach, nor suggest, a computer jukebox, which includes a money intake device, that stores digital songs and digital song associated graphic images. Thus, the Applicants respectfully submit that claims 16-17 and 20 should now be in condition for allowance.

Additionally, a person having ordinary skill in the art would not be motivated to combine Castille, Cohen, Verduin and Tashiro together. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984); *See also* MPEP 2143.01. It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather "some teaching or suggestion in the references to support their use in the particular claimed combination" is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988), the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

> Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

In the present application the Examiner attempts to combine Castille, a subscription network that does not teach, nor suggest, a computer jukebox, with Cohen, a home video communication system that does not teach, nor suggest, a computer jukebox and at least one of Verduin, a phonograph based jukebox that does not store songs or graphics digitally, and Tashiro, which is directed towards video game systems. In combining these references together, the Examiner has merely picked and chosen among isolated, individual elements of assorted prior art references in an attempt to re-create the Applicants' claimed invention. The Applicants respectfully submit that there is no teaching or suggestion in these references to support their use in the particular claimed combination.

The Applicants now turn to the rejection of claims 22-23 and 25-27 under 35 U.S.C. 103(a) as being unpatentable over Castille in view of Cohen. As discussed above, neither Castille, nor

Cohen, teach or suggest a computer jukebox. Obviously, neither teaches, nor suggests, a computer jukebox having a money intake device. Independent claims 22 and 27 have been amended to recite that the computer jukebox includes "a money intake device for receiving money of a user of the computer jukebox, wherein the user inserts money into the money intake device to play at least one song on the computer jukebox." Because neither Castille, nor Cohen, alone, or in combination with one another teach, nor suggest, a computer jukebox having a money intake device, the references cannot render claims of the present application obvious. Thus, claims 22-23 and 25-27 should be in condition for allowance.

The Applicants now turn to the rejection of claims 21 and 24 under 35 U.S.C. 103(a) as being unpatentable over Castille in view of Cohen in view of Official Notice. Claim 21 depends from claim 16 and claim 24 depends from claim 22. As discussed above, claims 16 and 22 should now be in condition for allowance. Therefore, claims 16 and 24 should also be in condition for allowance.
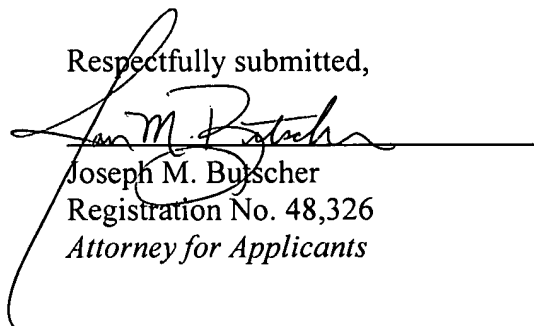
CONCLUSION

In light of the above, the Applicants request reconsideration of the application and look forward to working with the Examiner to resolve any remaining issues in the application.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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APPENDIX A

IN THE CLAIMS

16. (Amended/Marked-Up)   An improved computer jukebox for playing songs selected by users of the computer jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, where the library of songs stored in the computer jukebox is capable of being updated upon the receipt of compressed digital song data, which represents at least one song, upon the receipt of song identity data, which represents the identity of each such song, and upon receipt of compressed pictorial graphics which represent song associated pictorial graphics, and which are associated with the song identity data, the computer jukebox comprising:

a money intake device for receiving money of a user of the computer jukebox, wherein the user inserts money into the money intake device to play at least one song on the computer jukebox;

a communication interface for receiving the compressed digital song data and the song identity data;

a data storage unit for storing the received compressed digital song data, the received song identity data for each of the songs stored, and the compressed pictorial graphics, received by the communication interface;

a display for showing, to prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the data storage unit and that is based on song identity data;

selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys;

at least one audio speaker;

a processor; a memory connected with the processor, the memory including a decompression algorithm for decompressing compressed digital song data, instructions causing the processor, when no song is playing on the computer jukebox, to generate a user attract mode wherein digitally-stored song associated graphic images are shown on the display; and

the memory further including instructions for:

causing the processor, in response to the signal output, to access and process compressed digital song data retrieved from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys;

causing the processor to decompress the accessed compressed digital song data so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor; and

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox.

22. (Amended/Marked-Up) An improved computer jukebox network comprising: a plurality of computer jukeboxes where each computer jukebox is capable of playing songs selected by users of the computer jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox and where the library of songs is capable of being updated upon the receipt of compressed digital song data, which represents at least one song, and upon the receipt of song identity data which represents the identity of each such song; and a management station for updating the library of songs in each of the plurality of computer jukeboxes;

with each computer jukebox comprising:

a money intake device for receiving money of a user of the computer jukebox, wherein the user inserts money into the money intake device to play at least one song on the computer jukebox;

a communication interface for receiving the compressed digital song data and the song identity data;

a data storage unit for storing the received compressed digital song data and the received song identity data for each of the songs stored;

a display for showing, to prospective user of the computer jukebox, information based on song identity data for identifying the songs for which digital song data is stored in the data storage unit;

a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data; and

wherein the memory further includes instructions for:

causing the processor, in response to the signal output, to access and process compressed digital song data retrieved from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys;

causing the processor to decompress the accessed compressed digital song data so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed digital song data being decompressed and converted by the processor; and

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox; and

wherein the management station comprises:

a communication interface including a receiver and a transmitter; and

a management station processor connected to a management station memory, the management station memory including instructions for:

causing the management station processor to store digital song data, representing a set of songs, and song identity data, representing the identity of each song in the set of songs in a management station data storage unit;

causing the management station processor to compress digital song data stored in the management station data storage unit;

causing the management station processor to compress and transmit a subset of the digital song data and transmit corresponding song identity data to at least one selected computer jukebox to update the library of songs in the computer jukebox.

27. (Amended/Marked-Up)   An improved computer jukebox for playing songs selected by users of the computer jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, where the library of songs stored in the computer jukebox is capable of being updated upon the receipt of compressed digital song data, which represents at least one song, and upon the receipt of song identity data, which represents the identity of each such song, the computer jukebox comprising:

~~a money intake device for receiving money of a user of the computer jukebox, wherein the user inserts money into the money intake device to play at least one song on the computer jukebox;~~

a communication interface for receiving the compressed digital song data and the song identity data;

a data storage unit for storing the received compressed digital song data and the received song identity data for each of the songs stored;

a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the data storage unit and that is based on song identity data;

a processor and a memory, the memory including a decompression algorithm for decompressing compressed digital song data; the memory further including instructions for:

causing the processor, in response to the signal output, to access and process compressed digital song data retrieved from the data storage unit so that the accessed compressed digital song data corresponds to the song selected;

causing the processor to decompress the accessed compressed digital song data so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor; and

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox.